

REMARKS

Introductory Comments:

Claims 1-19 were examined in the Office Action dated November 30, 2005.

Claims 8, 9 and 10 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 4,863,316 to Gianella *et al.* (Gianella)

Claims 1 and 2 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gianella.

Claims 3, 4, and 5 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gianella in view of U.S. Patent No. 4,561,808 to Spaulding *et al.* (Spaulding)

Claim 11 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gianella in view U.S. Patent No. 5,727,732 to Stein.

Claim 14 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gianella in view Spaulding.

Claims 8 and 15 were rejected under 35 U.S.C. §112 as lacking antecedent basis.

Claim 19 was objected to for depending from claim 15 rather than claim 18.

Claims 6, 7, 12, 13, and 16-19 were said to have allowable subject matter.

SUPPORT FOR AMENDMENTS

The specification has been amended to correct the name of one of the inventors. In the application as filed, the first name and the last name had been mistakenly transposed. The amendment corrects for an inadvertent oversight.

Claims 1 and 15 have been amended to delete the word “the” from the phrase “the other portion loops back.” The amendment corrects the antecedent basis of the phrase.

Claim 8 has been amended to recite the limitation of Claim 12. The amendment finds support in the claims as filed and through out specification.

Claim 12 has been canceled.

Claim 13 has been amended to correct the dependence. It now depends from the independent claim 8 instead of the now canceled claim 12.

Claim 19 has been amended to depend from claim 18 instead of claim 15. The applicants thank the Examiner for suggesting the amendment.

New claims 20-25 have been added. The new independent claim 20 is still pending claim 6 rewritten in independent form, and includes all the limitations of the base claim except for the electromagnet. The new claims finds support in the claims as originally filed and through out specification, such as, for example, Figure 1.

Accordingly, no new matter has been added by way of this amendment and the entry thereof is respectfully requested.

Addressing the Examiner’s Rejections

Rejections of the Claims Under 35 U.S.C. §102

The Examiner has rejected claims 8, 9 and 10 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 4,863,316 to Gianella *et al.* (Gianella). The applicants have amended claim 8 to include the limitation of claim 12 that was said to

contain allowable subject matter. The Examiner is therefore respectfully requested to withdraw the rejection.

Rejections of the Claims Under 35 U.S.C. §103(a)

(a) The Examiner rejected claims 1 and 2 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gianella.

The applicants traverse the rejection as the Office has not established a *prima facie* case of obviousness for which three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claim 1 recites that the discharge end is bifurcated wherein one portion connects to the ejector and other portion discharges the aerosol of the powder. Gianella does not disclose this element of the claim. Since the reference does not disclose all the elements of the claimed invention, the Examiner is respectfully requested to withdraw the rejection.

In the apparatus disclosed by Gianella, the discharge end of the conduit (86) is bifurcated, where one portion discharges the powder to a sprayer, while the other portion (84) is connected to a differential pressure transducer (80). The transducer measures the differential between the feed gas pressure in the hopper (via tube (82)) and the carrier conduit pressure (Gianella, column 6, lines 11-16). The Gianella apparatus does not disclose that the portion (84) is connected with

the pickup section (21) which might serve the same function as the ejector described by the applicants. Thus, in the Gianella apparatus, the portion (84) is not connected to the ejector as claimed by the applicants in Claim 1. The reference does not disclose all the elements of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw the rejection.

(b) The Examiner rejected claims 3, 4, and 5 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gianella in view of U.S. Patent No. 4,561,808 to Spaulding *et al.* (Spaulding).

The applicants traverse the rejection. Claims 3, 4, and 5 are dependent claims, and, therefore, contain all the limitations of the claims from which they depend. The claims from which claims 3, 4, and 5 depend are patentable over the cited art since the combination of Gianella and Spaulding does not disclose that the discharge end is bifurcated wherein one portion connects to the ejector and other portion discharges the aerosol of the powder. The combination of Gianella and Spaulding does not disclose all the elements of the claims, therefore, a *prima facie* case of obviousness has not been made. The Examiner is respectfully requested to withdraw this rejection.

(c) The Examiner rejected claim 11 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gianella in view of Stein.

The applicants traverse the rejection. Claim 11 is a dependent claim, and, therefore, contains all the limitations of the claim from which it depends. The independent claim 8 and the dependent claim 10 from which claim 11 depends are patentable over the cited art since the combination of Gianella and Stein does not disclose that the discharge end is bifurcated wherein one portion connects to the ejector and other portion discharges the aerosol of the powder, or that the ratio of diameter of the first end to the ejector is about 1.1 to about 4. The combination of

Gianella and Stein does not disclose all the elements of the claim, therefore, a *prima facie* case of obviousness has not been made. The Examiner is respectfully requested to withdraw this rejection.

(d) The Examiner rejected claim 14 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gianella in view Spaulding.

The applicants traverse the rejection. Claim is a dependent claim, and, therefore, contains all the limitations of the claim from which it depends. The independent claim 8, from which claim 14 depends, is patentable over the cited art since the combination of Gianella and Spaulding does not disclose that the discharge end is bifurcated wherein one portion connects to the ejector and other portion discharges the aerosol of the powder, or that the ratio of diameter of the first end to the ejector is about 1.1 to about 4. The combination of Gianella and Stein does not disclose all the elements of claim 14, therefore, a *prima facie* case of obviousness has not been made. The Examiner is respectfully requested to withdraw this rejection.

Rejections of the Claims Under 35 U.S.C. §112

The Examiner rejected claims 8 and 15 under 35 U.S.C. §112 as lacking antecedent basis. The limitation “the other portion” recited in the claims was said to have insufficient antecedent basis. The applicants have amended the claims to delete “the” and, therefore, believe that claims 8 and 15 as amended satisfy the requirements of 35 U.S.C. §112. Therefore, the Examiner is respectfully requested to withdraw this rejection.

OBJECTIONS

Claim 19 was objected to for depending from claim 15 rather than claim 18. The applicants agree with the Examiner, and have amended claim 19 to depend from claim 18.

DRAWINGS

The Examiner objected to the drawings because they are too dark. The applicants are including formal drawing of Figure 1 in compliance with 37 CFR 1.121(d) with this amendment.

CONCLUSION

Applicants respectfully submit that the claims define an invention that is patentable over the art, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicants' representative at (650) 335-7818.

Respectfully submitted,
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